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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ITC DeltaCom Communications, Inc.

Serial No. 76463530

I.C. Wadley, Jr. of Wadley & Patterson for applicant.

Leigh C. Case, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Seeherman, Quinn and Holtzman, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by ITC DeltaCom
Communications, Inc. to register the mark shown below

grapevine
EVERYBODY'S TALKING.

for "local and long distance telephone services; and providing multiple user dial-up and dedicated access to the Internet".¹

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, if used in connection with applicant's services, would so resemble the previously registered marks GRAPEVINE (typed) and



both for "pay telephone terminals,"² as to be likely to cause confusion. The registrations are owned by the same entity.

When the refusals were made final, applicant appealed. Applicant and the examining attorney filed briefs. An oral hearing was not requested.

Applicant first argues that the involved marks are different in appearance, sound, connotation and commercial

¹ Application Serial No. 76463530, filed November 1, 2002, based on an allegation of a bona fide intention to use the mark in commerce.

² Registration No. 2466625, issued July 3, 2001, and Registration No. 2462820, issued June 19, 2001, respectively.

impression, and that, in any event, the term "grapevine" is suggestive as applied to the involved goods and services. Applicant also contends that its services clearly differ from the goods of registrant and, more significantly, the goods and services are bought by different classes of purchasers who are relatively sophisticated; "one customer is a business, the other is a consumer; one buys from a distributor of equipment, the other buys services over the phone or the Internet." (Brief, pp. 11-12). In this regard, applicant asserts that its services are bought by everyday consumers whereas registrant's goods would be purchased by businesses which "weigh such factors as location, profitability, customer volume, security, accessibility, customer request for service, projected usage, and features of the terminal itself before purchasing and installing a pay phone terminal." (Brief, p. 11). Applicant also points to pricing differences between the goods and services. Applicant has introduced excerpts from various web sites, including its own and registrant's, as well as third-party registrations "where goods have been registered in International Class 9 under one mark, and services have been registered in International Class 38 under a similar mark, both to different owners." (Brief, p. 9). Applicant also has

relied upon an informational brochure from a third party and a dictionary definition of the term "grapevine" showing it defined as "the informal transmission of information, gossip, or rumor." *The American Heritage College Dictionary* (4th ed. 2002).

The examining attorney maintains that the marks are similar in that applicant's mark is dominated by the term "GRAPEVINE" which is identical to the entirety of registrant's typed mark, and which is identical to the dominant feature of registrant's logo mark. According to the examining attorney, "a consumer who encounters the mark GRAPEVINE on a pay telephone and on an advertisement for telephone services would logically believe that the goods and services come from a common source" and that an examining attorney "must consider any goods or services in the registrant's normal fields of expansion to determine whether the registrant's goods or services are related to the applicant's identified goods or services under Section 2(d)." (Brief, p. 4). In support of the refusal, the examining attorney submitted four third-party registrations (of which only two are based on use in commerce) which show, according to the examining attorney, that entities have registered a single mark for both pay telephones and telephone services.

In reply, applicant contends (Reply Brief, p. 12) that the likelihood of confusion scenario set forth by the examining attorney is conclusory and only a remote possibility:

[A] consumer looking for local, long-distance or Internet services is not likely to also be looking to purchase a coin-operated pay phone terminal. Those products are purchased by businesses that are in the business of installing such equipment. The only possible prospect of confusion is by the purchaser of the Registrant's equipment when that purchaser goes to sign up for local or long-distance service.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to consider the marks. Although the marks must be considered in their entirety, it is nevertheless the case that, in articulating reasons for

reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety." In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant's mark is dominated by the term "GRAPEVINE," as is registrant's logo mark. The grape bunch design in each mark serves to emphasize this term. See In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); In re Decombe, 9 USPQ2d 1813 (TTAB 1988); and In re Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987) [literal portion generally dominates design feature]. Further, in applicant's mark, the term "GRAPEVINE" appears in larger letters than the subordinate words "EVERYBODY'S TALKING" which appear below and in smaller type; this dominant "GRAPEVINE" portion of each of the logo marks, which is also the entirety of registrant's typed mark, is what purchasers are most likely to remember and use in calling for the goods and services.

In view of the above, we find applicant's mark and both of registrant's marks to be similar in sound and appearance. Although there are specific differences

between the marks, the similarities in sound and appearance outweigh these differences.

The connotations of the marks are also similar. We recognize the suggestiveness of the term "grapevine" as used in connection with the telephonic goods and services (that is, an informal way of spreading news or gossip from one person to another). Nonetheless, both marks convey the same suggestion, that is, the goods and services provide a means of communicating with someone else. The addition of the words "EVERYBODY'S TALKING" in applicant's mark does not diminish this meaning but rather adds to the meaning of spreading news or gossip (as in "everybody's talking about...."). Although applicant contends that the marks have different connotations, applicant has failed to offer any alternative meanings.

In sum, we find that the marks are similar in sound, appearance and meaning and that, when considered in their entirety as applied to the goods and services, they engender similar overall commercial impressions.

With respect to the goods and services, as has been often stated, it is not necessary that the goods and/or services of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that

the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

As applicant acknowledges, its local and long distance telephone services and registrant's pay phones all fall within the category of telecommunications. It is applicant's contention, however, that there are "clear differences" between the goods and services, and that the goods and services would be purchased by different classes of purchasers who are sophisticated.

In comparing the goods and services, we have focused on applicant's local and long distance telephone services vis-à-vis registrant's pay telephones. See Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) [likelihood of confusion may be found on basis of any item in an application's identification of goods]. We find that there is an inherent relatedness between, on the one hand, local and

long distance telephone services, and pay telephones on the other.

Although pay telephones may be purchased by business customers, these phones will be used by ordinary consumers, perhaps even by employees of the business itself. These users will be exposed to registrant's marks on the pay phones. These same users also will be consumers for local and long distance telephone services and, in choosing such services, they would be exposed to applicant's similar mark. Thus, ordinary consumers who use the pay telephones are likely to be confused because they also would be consumers of telephone communication services. See *In re Artic Electronics Co.*, 220 USPQ 836 (TTAB 1983) [MARS for coin-operated video games likely to cause confusion with MARS for automatic change-making machine; while video arcade owner-purchasers may not be confused, arcade customers who use the two machines are likely to be confused]. Likelihood of confusion of users falls under the category of confusion which Section 2(d) is designed to prevent.

As additional evidence of the relatedness of the goods and services, the examining attorney submitted two use-based third-party registrations covering both pay telephones and telephone communication services. Third-

party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Although this evidence is limited, it lends support to our view of the relatedness of the goods and services. Certainly, it is more persuasive than the third-party registrations relied upon by applicant. Applicant "submits that there are also many instances where goods have been registered in International Class 9 under one mark, and services have been registered in International Class 38 under a similar mark, both to different owners." These registrations offer little help to applicant; we are not privy to the records in any of these registrations, and we are not bound, of course, by any prior determinations made by the Office. We would also point out that none of the examples offered by applicant involve marks as similar to each other as the ones involved herein.

One of applicant's arguments pertaining to the goods and services is that there is a "huge disparity" in their pricing which "is yet another distinguishing factor that would indicate that there is no likelihood of confusion between the goods and services involved," pointing to

excerpts from applicant's and registrant's web sites. (Brief, p. 12). To the extent that this argument is connected to applicant's contention that business customers would be sophisticated, we reiterate that one segment of the users of applicant's services and registrant's goods is the general public.

We conclude that, in view of the similarities between the marks and the goods and services offered thereunder, confusion is likely to occur in the marketplace.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., supra; and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusals to register are affirmed.